

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 2-10-02

APPL. S.N.: 091727631

EXAMINER: T. N. K. R. V. A.

ART UNIT: 1913

PARALEGAL: Anne

MAILROOM DATE: 1.28

AFTER FINAL: YES___ NO~~X~~

NUMBER OF T.D.(S) FILED: 1

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please se our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

- ☒ The T. D. is PROPER and has been recorded. (See 14.23)
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)
- ☐ The recording fee of \$_____ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)
- ☐ Application Examiner has not processed fee for T. D.
- ☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)
- ☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)
- ☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)
- ☐ The person who signed the terminal disclaimer:
- ☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)
- ☐ is not recognized as an officer of the assignee. (See 14.29.1)
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72) NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)
- ☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)
- ☐ The T. D. is not signed (See 14.26 and 14.26.3)
- ☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)
- ☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)
- ☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)
- ☐ Other _____



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert Medsker et al.

Examiner: Zalukaeva

Serial No.: 09/727,637

Group Art Unit: 1713

Filed: December 1, 2000

For: MONOHYDRIC POLYFLUOROOXETANE OLIGOMERS, POLYMERS,
AND COPOLYMERS AND COATINGS CONTAINING THE SAME

Commissioner of Patents & Trademarks
Washington, D.C. 20231

RECEIVED
JAN 31 2003
TC 1700

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION
OVER A PRIOR PATENT**

Sir:

OMNOVA Solutions Inc. and Aerojet-General Corporation, Petitioners, are the owners of an undivided 100 percent interest in the instant application as evidenced by copies of the Assignments attached hereto (Exhibits A and B). The Petitioners hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to 156 and 173 as shortened by any terminal disclaimer, of its commonly owned U.S. Patent 6,403,760, granted June 11, 2002, based upon Application Serial No. 09/473,518, filed December 28, 1999, which was a parent application to this continuation-in-part application of which the Petitioners, OMNOVA Solutions Inc. and Aerojet-General Corporation are the owners of an undivided 100 percent interest therein as evidenced by copies of the Assignments attached hereto (Exhibits C and D). The Petitioners hereby agree that any patent so granted on the instant application shall be enforceable only for and during such period that it and U.S. Patent 6,403,760 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioners do not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to 156 and 173 of U.S. Patent 6,403,760 as presently shortened by any terminal disclaimer, in the event that any such granted patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a

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court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

For submissions on behalf of OMNOVA Solutions Inc. and Aerojet General Corporation, the undersigned (whose titles are supplied below) are empowered to act on behalf of OMNOVA Solutions Inc. and Aerojet-General Corporation.

We hereby declare that we have reviewed appropriate evidentiary documents and certify that, to the best of our knowledge and belief, title to the instant application and to said commonly owned U.S. Patent 6,403,760 is in OMNOVA Solutions Inc. and Aerojet-General Corporation.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

The statutory fee of \$110.00 is to be charged to Deposit Account No. 07-1045

The Commissioner is hereby authorized to charge or credit any deficient or excess fees in this matter to Deposit Account No. 07-1045.

OMNOVA SOLUTIONS INC.

Date: Jan. 17, 2003

David G. Burleson
David G. Burleson, Assistant Secretary

AEROJET-GENERAL CORPORATION

Date: Nov. 5, 2002

Brian E. Sweeney
Brian E. Sweeney, Assistant Secretary

Attorney Docket No.: GT-5241

(GC-FK-CIP)